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**BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES**

Application Number: 10/777,646

Filing Date: February 12, 2004

Appellant(s): KEOHANE ET AL.

Amy J. Patillo

For Appellant

EXAMINER'S ANSWER

This is in response to the appeal brief filed 12/09/2008 appealing from the Office action mailed 03/18/2008.

(1) Real Party in Interest

A statement identifying by name the real party in interest is contained in the brief.

(2) Related Appeals and Interferences

The examiner is not aware of any related appeals, interferences, or judicial proceedings which will directly affect or be directly affected by or have a bearing on the Board's decision in the pending appeal.

(3) Status of Claims

The statement of the status of claims contained in the brief is **incorrect**. The brief lists Claims Cancelled as: 2-4, 8, 9, and 13-19. However, claim 7 is also cancelled. The following is the correct Status of Claims:

1. Status of All Claims in Application

- a. Claims Rejected: 1, 5, 6, and 10-12.
- b. Claims Allowed or Confirmed: None.
- c. Claims Withdrawn from Consideration: None.

- d. Claims Objected to: None.
- e. Claims Cancelled: 2-4, 7-9, and 13-19.

2. Claims on Appeal

- a. The claims being appealed are: 1, 5, 6, and 10-12.
- b. The claims being appealed stand finally rejected as noted by the Examiner in the Examiner's Action dated June 17, 2008.

(4) Status of Amendments After Final

The Appellant's statement of the status of amendments after final rejection contained in the brief is correct.

(5) Summary of Claimed Subject Matter

The summary of claimed subject matter contained in the brief is correct.

(6) Grounds of Rejection to be Reviewed on Appeal

The Appellant's statement of the grounds of rejection to be reviewed on appeal is correct.

(7) Claims Appendix

The copy of the appealed claims contained in the Appendix to the brief is correct.

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(8) Evidence Relied Upon

The following is a listing of the prior art of record relied upon in the rejection of claims under appeal:

1. U.S. 2006/0026236 to Scian et al. filed on Feb. 7, 2003, and published on Feb. 2, 2006.
2. Microsoft, Windows XP Automatically Expanding a Display Directory, 2001.
3. "Integrating Constraints and Direct Manipulation" by Michael Gleicher.
Proceedings 1992 Symposium on Interactive 3d graphics. Pg. 171-174.

(9) Grounds of Rejection

The following ground(s) of rejection are applicable to the appealed claims:

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

1. Claims 1, 6, and 11 are rejected under 35 U.S.C. 103(a) as being unpatentable over Scian et al. (Scian, hereinafter) US Patent Application 2006/0026236 in further view of "Windows XP Automatically Expanding a display directory." (Microsoft, hereinafter).

As to claim 1, Scian teaches A method for providing electronic message filing recommendations comprising (the abstract states "in a computer system, a system, method and computer program product for pre-selecting a folder for a current message. Paragraph [0001] also states that "the present invention relates generally to message storage and more particularly relates to pre-selecting a folder from a plurality of folders for storing a message."):

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detecting, at a sender system, a sender selection within a user interface of at least one suggested folder name for a composed electronic message for a recipient receiving~ the electronic message to select as a folder name for filing said electronic message (Scian clearly teaches in paragraph [0045] that "if the current message is an outgoing message, then the pre-selected folder 22 is presented as the folder in which the user can find the file to be attached to the current message. In both cases, of course, the user is free to override the pre-selection and to select another file folder." It is clearly taught that a user through an override can select a file folder for suggested filing purposes. In this instance Scian is speaking about messages with attachments, and it is interpreted that an attachment which is sent electronically is an electronic message. Further clarity is found when Scian teaches what happens when an incoming message with a pre selected folder is received. Scian teaches in paragraph [0045] that "If the current message is an incoming message, then the pre-selected folder 22 is for storing the attachment. That is, if the user indicates that he or she wishes to save the attachment, then the system will present the pre- selected file as an easily executable option." It can be seen that the pre-selected folder is presented to the user as a choice for filing. Additionally paragraph [0027] teaches the same method of selecting folders for the message without attachments.);

attaching said at least one suggested folder name to said electronic message at said sender system for distribution to said recipient (Paragraph [0045] teaches that a folder is selected and associated with the sent electronic message.);

responsive to receiving said electronic message at a recipient system for said recipient, filtering said electronic message to detect said at least one suggested folder name specified by said sender in said electronic message for filing said electronic message from among a plurality

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of filing folders in a messaging filing directory (Scian clearly teaches in paragraph [0045] that "If the current message is an incoming message, then the pre-selected folder 22 is for storing the attachment. That is, if the user indicates that he or she wishes to save the attachment, then the system will present the pre-selected file as an easily executable option." In this case the pre-selected folder is presented to the user for suggested filing. In this instance Scian is speaking about messages with attachments, and it is interpreted that an attachment which is sent

electronically is an electronic message. Additionally paragraph [0027] teaches the same method of selecting folders for the message with or without attachments.): and

responsive to said recipient selecting to file said electronic message, to display said at least one suggested folder in a graphically distinguishable format from said display of other folders of said plurality of filing folders, such that a recommendation of relevant folders for filing said electronic message is provided.

But Scian does not teach automatically expanding a display directory of said plurality of filing folders.

However, Microsoft teaches automatically expanding a display directory_ of said plurality of filing folders (Steps 1-4 show when a user is filing a file or folder into a target directory, the intended target filing folder will automatically expand after the cursor hovers over the target filing folder for a few seconds.).

It would have been obvious at the time of the invention by one of ordinary skill in the art to combine Scian's method for providing electronic message filing recommendations with Microsoft's method of automatically expanding a folder since automatically expanding a folder would allow a user to view all of the available subdirectories or contents of the expanded folder.

2. Claims 6 and 11 are rejected for the same reasons as claim 1.
3. Claims 5, 10, and 12 are rejected under 35 U.S.C. 103(a) as being unpatentable over the combination of Scian et al. US Patent Application 2006/0026236 and "Windows XP Automatically Expanding a display directory" in further view of Michael Gleicher's article "Integrating Constraints and Direct Manipulation" appearing in Proceedings 1992 Symposium on Interactive 3D Graphics pages 171-174 (Gleicher, hereinafter).

As to Claim 5, the combination of Scian and Microsoft teach all of the limitations of claim 1, but does not teach responsive to detecting an icon for said particular electronic message dragged into a display region for said plurality of filing folders, automatically positioning said icon over said at least one suggested folder.

However, in an analogous art, Gleicher discloses the combination of snapping techniques and constraint techniques which teaches responsive to detecting an icon for said particular electronic message dragged into a display region for said plurality of filing folders, automatically positioning said icon over said at least one suggested folder. Automatic positing of and icon while dragging is widely known as a type of direct manipulation for user interfaces. Snap-to-locations are frequently used in graphical user interfaces, and in such systems objects which are being dragged will be automatically positioned most often according to a grid location. Gleicher combines such direct manipulation techniques with constraints that can be set to automatically position the object according to the constraint. It is interpreted that applicants system is using a

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constraint based direct manipulation method, where the constraint is the corresponding suggested folder, and the direct manipulation is the dragging of an icon.

Therefore, it would have been obvious to one of ordinary skill in the art to combine Gleicher's constraint based direct manipulation with Scian's method for providing electronic message filing recommendations because as Gleicher suggests in the 1st paragraph of his article that "by integrating constraints with direct manipulation, it is possible to build system that provide the power of explicit representation of geometric relationships and the properties which make direct manipulation so attractive."

4. Claims 10 and 12 are rejected under the same grounds and reasons as claim 5.

(10) Response to Argument

In the Argument, Appellant argued in substance that:

(A) There is no clear statement as to the rationale for one of ordinary skill in the art in finding claim 1 as a whole obvious in view of Scian and Microsoft as recited in claim 1.

As to point (A), The Final Office Action mailed 03/18/2008 detailed the reason to combine the teachings of Scian and Microsoft. In summary, it would have been obvious at the time of the invention by one of ordinary skill in the art to combine Scian's method for providing electronic message filing recommendations with Microsoft's method of automatically expanding a folder to enable a user to view all of the available subdirectories or contents of the automatically expanding folder.

(B) The combination of Scian and Microsoft does not teach “detecting, at a sender system, a sender selection within a user interface of at least one suggested folder name for a composed electronic message for a recipient receiving the electronic message to select as a folder name for filing said electronic message, attaching said at least one suggested folder name to said electronic message at said sender system for distribution to said recipient, and sending said electronic message with said suggested filing folder name from said sender system to a recipient system for said recipient.”

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As to point **(B)**, The object of Scian is to pre-select a folder for a current message (Scian, [0007-0008], “An object of a second aspect of the invention is to provide an improved method for pre-selecting a folder for a current message.”). The folders are selected using configurable entries (Scian, [0011]) which are provided by the user (Scian, [0028]). The system attaches attributes to the message which are used in the selection of a folder (Scian, [0021-0023], [0044-0046]). Selection of the folder is made based upon such attributes as the subject or the sender of a message (Scian, [0021].) The message is sent or received and the system acts on the current message (Scian, [0019-0020], the system includes a communication module for receiving or transmitting the current message, [0024], [0044-0045].) For example, see [0044-0045] which discloses that the pre-selected file folder associated with the current message will be for storing the attachment (i.e. pre-selecting a folder for a current message) if the message is an incoming message. However if the message is an outgoing message the pre-selected folder is presented as the folder in which the user can find the file associated with the current message.) Further, [0029] of Scian discloses that a new message is transmitted or received and then allocated by the user to a particular folder. This allocation is referring to the disclosure of [0027] which details how a user can approve the pre-selected folder or allocate the message to another folder. Accordingly, Scian discloses both the sending and receiving end associated with embodiments of the system which pre-selects a folder for a current message.

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(C) The combination of Scian and Microsoft does not teach “attaching said at least one suggested folder name to said electronic message at said sender system for distribution to said recipient.”

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As to point (C), A folder is pre-selected based on attributes of the message (Scian, [0022]), for example, a folder for a message may be pre-selected based on the time sent attribute (Scian, [0023]). Scian discloses sending the message to a recipient in at least [0019] and [0045].

(D) The combination of Scian and Microsoft does not teach “responsive to receiving said electronic message at said recipient system for said recipient, filtering said electronic message to detect said at least one suggested folder name specified by said sender in said electronic message for filing said electronic message from among a plurality of filing folders in a messaging filing directory.”

As to point (D), Scian in [0027] discloses a user interface including means for displaying the current message as well as the pre-selected folder (among a plurality of folders) for the received message (Scian, [0029]). See also the references to paragraphs [0027-0029].

(11) Related Proceeding(s) Appendix

No decision rendered by a court or the Board is identified by the examiner in the Related Appeals and Interferences section of this Examiner's answer.

Respectfully submitted,

/R. J./

Examiner, Art Unit 2445

/Larry D Donaghue/

Primary Examiner, Art Unit 2454

Conferees:

/Larry D Donaghue/

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